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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,455	10/23/2001	George J. Just		8730

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GEORGE J. JUST
SUITE 102
2126 N. SAWYER AVE.
CHICAGO, IL 60647

EXAMINER

BRITTAIN, JAMES R

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/982,455	Applicant(s) JUST, GEORGE J.	
	Examiner James R. Brittain	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-32 is/are pending in the application.
4a) Of the above claim(s) 21-23 and 25 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29 is/are allowed.
- 6) ☒ Claim(s) 18-20, 24 and 30-32 is/are rejected.
- 7) ☒ Claim(s) 26-28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restriction

Applicant's election without traverse of Group I; in Paper No. 09022003 is acknowledged.

Claims 21-23 and 25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 09022003.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103 as obvious over Bender (US 5517722).

Bender (figures 2-5) teaches magnetic clasp structure comprising a planar magnetic member 22, a planar ferric armature member 14 randomly juxtaposed with respect to longitudinal orientation thereby permitting location anywhere on the surfaces, and magnetically attached to the magnetic member, and means for allowing the juxtaposed members to pivotally

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separate at one side in response to application of a squeezing force at the opposite side of the members. This is inherently provided by the cooperating plates 14, 18 that are inherently capable of pivoting about the edge of the magnetic member 22 for allowing the juxtaposed members to pivotally separate at one side in response to application of a squeezing force at the opposite side of the members. While the device is not stated as being used as a bookmark, it is inherently capable of such a use. Note that Bender contemplates an overall diameter of 1.5 inches with the magnet having a diameter of 5/16 inches and a thickness of 3/16 inches (col. 4, lines 46-50), dimensions usable for a bookmark.

Claims 19, 24 and 31 are rejected under 35 U.S.C. §103(a) as being unpatentable over Bender (US 5517722) in view of Schuller (DE 29717216).

Bender (figures 2-5) teaches magnetic clasp structure comprising a planar magnetic member 22, a planar ferric armature member 14 randomly juxtaposed with respect to longitudinal orientation and magnetically attached to the magnetic member, and means for allowing the juxtaposed members to pivotally separate at one side in response to application of a squeezing force at the opposite side of the members. This is inherently provided by the cooperating plates 14, 18 that are inherently capable of pivoting about the edge of the magnetic member 22 for allowing the juxtaposed members to pivotally separate at one side in response to application of a squeezing force at the opposite side of the members. While the device is not stated as being used as a bookmark, it is inherently capable of such a use. The difference is that there is no hinged connection between the two members. However, Schuller (figures 1, 2) teaches providing a hinged connection in the form of the ring 19 between the two members 22, 22a that would permit a hinged motion between them. While this attachment is a ring and not

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film as applicant discloses, it is the equivalent because it connects the ends of the plates 22, 22a, thereby acting in the same location as applicant's film, and extends beyond the ends of the plate, again located and acting in the same location as applicant's film. The attachment taught by Schuller maintains the two parts of the magnetic clasp together, thus lessening the chance of loss of a single piece of the clasp while also permitting easier manipulation with one hand by maintaining the two together. As it would be advantageous to lessen the chance of losing a single component of the clasp of Bender while also enhancing its ability to be manipulated with one hand, it would have been obvious to modify the clasp of Bender so that the members are hingedly attached as taught by Schuller. As to claim 24, Bender suggests the use of a second plate 18 secured to the magnetic member that is of like dimension to plate 14 and while a decorative dome 20 is secured to the plate, Schuller suggests dispensing with the decorative dome and maintaining the two plates 22, 22a alone of like dimension thereby rendering obvious the subject matter of this claim. As to claim 31, this claim combines the features of 18, 19 and 24. The subject matter of this claim is obvious over the combined references for the combination of reasons addressing each of these claims alone.

Claims 20 and 32 are rejected under 35 U.S.C. §103(a) as being unpatentable over Bender (US 5517722) in view of either one of Wheatley (US 2693370) or JP 2000-343864.

Bender (figures 2-5) teaches magnetic clasp structure comprising a planar magnetic member 22, a planar ferric armature member 14 randomly juxtaposed with respect to longitudinal orientation and magnetically attached to the magnetic member, and means for allowing the juxtaposed members to pivotally separate at one side in response to application of a squeezing force at the opposite side of the members. This is inherently provided by the

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cooperating plates 14, 18 that are inherently capable of pivoting about the edge of the magnetic member 22 for allowing the juxtaposed members to pivotally separate at one side in response to application of a squeezing force at the opposite side of the members. While the device is not stated as being used as a bookmark, it is inherently capable of such a use. The difference is that the means for allowing the juxtaposed members to separate is not a beveled edge on the magnetic member. However, Wheatley (figures 1-3, 5, 6) teaches magnetic clip structure including a magnetic member 13, 13a, a ferric armature member, A, juxtaposed and magnetically attached to the magnetic member and the base, A, extending beyond the fulcrum 25 formed by the beveled face 21 by which a squeezing force can be inherently applied so as to open the clamping faces thereby providing for a more controlled operation of the magnetic clasp. Similarly, Japanese publication 2000-343864 (figures 4-6) teaches magnetic clip structure including two hingedly juxtaposed magnetically attracted members 22a, 22b wherein the portions extending to the right of the fulcrum 14, 16 are beveled for allowing the juxtaposed members to pivotally separate at one side in response to application of a squeezing force thereby providing for a more controlled operation of the magnetic clasp. As it would be advantageous to provide the magnetic clasp of Bender with a better controlled pivoting separation, it would have been obvious to modify the magnetic clasp of Bender with a magnet having a beveled edge in view of Wheatley or alternatively in view of JP 2000-343864 suggesting such structure to be beneficial so as to better control the pivotal action of the clasp. In regard to claim 32, Bender (figures 2-5) teaches magnetic clasp structure comprising a planar magnetic member 22 and also a permanent planar cooperating magnet member 14 (col. 6, lines 30-34) inherently having opposite polarities so that they are magnetically attracted to each other so as to cooperate, and means for allowing the

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juxtaposed members to pivotally separate at one side in response to application of a squeezing force at the opposite side of the members. This is inherently provided by the cooperating plates 14, 18 that are inherently capable of pivoting about the edge of the magnetic member 22 for allowing the juxtaposed members to pivotally separate at one side in response to application of a squeezing force at the opposite side of the members. While the device is not stated as being used as a bookmark, it is inherently capable of such a use. The difference is that there is not a beveled edge on one of the magnetic members. However, Wheatley (figures 1-3, 5, 6) teaches magnetic clip structure including a magnetic member 13, 13a, a ferric armature member, A, juxtaposed and magnetically attached to the magnetic member and the base, A, extending beyond the fulcrum 25 formed by the beveled face 21 by which a squeezing force can be inherently applied so as to open the clamping faces thereby providing for a more controlled operation of the magnetic clasp. Similarly, Japanese publication 2000-343864 (figures 4-6) teaches magnetic clip structure including two hingedly juxtaposed magnetically attracted members 22a, 22b wherein the portions extending to the right of the fulcrum 14, 16 are beveled for allowing the juxtaposed members to pivotally separate at one side in response to application of a squeezing force thereby providing for a more controlled operation of the magnetic clasp. As it would be advantageous to provide the magnetic clasp of Bender with a better controlled pivoting separation, it would have been obvious to modify the magnetic clasp of Bender with a magnet having a beveled edge in view of Wheatley or alternatively in view of JP 2000-343864 suggesting such structure to be beneficial so as to better control the pivotal action of the clasp.

Claim 30 is rejected under 35 U.S.C. §103(a) as being unpatentable over Bender (US 5517722) in view of Korkames (US 5103756).

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Bender (figures 2-5) teaches magnetic clasp structure comprising a planar magnetic member 22, a planar ferric armature member 14 randomly juxtaposed with respect to longitudinal orientation and magnetically attached to the magnetic member, and means for allowing the juxtaposed members to pivotally separate at one side in response to application of a squeezing force at the opposite side of the members. This is inherently provided by the cooperating plates 14, 18 that are inherently capable of pivoting about the edge of the magnetic member 22 for allowing the juxtaposed members to pivotally separate at one side in response to application of a squeezing force at the opposite side of the members. While the device is not stated as being used as a bookmark, it is inherently capable of such a use. The difference is that while indicia is placed upon the magnetic clasp, there is no signage. However, Korkames (figure 2) teaches the well known use of a bookmark for carrying information and acting as a sign through its carrying of commercial advertising, a corporate logo or a political message (col. 2, lines 49-52). As the use of available display surface for advertising purposes is beneficial to a vendor and would be therefore be desirable to place upon the magnetic clasp of Bender, it would have been obvious to modify the magnetic clasp of Bender so as to display advertising in view of Korkames teaching that it is desirable to display advertising upon magnetic clasps.

Allowable Subject Matter

Claims 26-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 29 is allowed.

Response to Arguments

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Applicant's arguments filed April 25, 2003 have been fully considered but they are not persuasive. Insofar as applicant's remarks are pertinent to the new grounds of rejection, applicant argues the intended use as a bookmark. In response to applicant's argument that the description of the device as a bookmark adds features beyond that of the applied art, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Applicant argues the size of the magnetic clip must be inferred from the use of the term "bookmark" and that magnetic clips utilized to hold documents would not function as well as bookmarks. In response, bookmarks not only are used in conjunction with closed books but also as line markers in open books. Further, applicant is not claiming any size to distinguish a "bookmark" from those that are applied as art above and the possible damage to the pages of a book applicant alludes to in his argument is not just a function of the bookmark but also the toughness of the paper used in the book and young children's books are well known to use pages that are very tough to damage. The device of Bender is also small, comparable to applicant's and fully capable of being used as a bookmark.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Parker (US 3253194, figure 1) teaches pertinent beveled magnet structure and Burke et al. (US 5771618, figure 1) teaches pertinent magnetic clip structure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James R. Brittain whose telephone number is 703-308-2222. The examiner can normally be reached on M, W & F 5:30-1:30, T 5:30-2:00 & TH 5:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James R. Brittain
Primary Examiner
Art Unit 3677

JRB